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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,450	03/22/2001	Krishanu Seal	AMAZON.063A	7645

20995 7590 02/13/2006

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IRVINE, CA 92614

EXAMINER
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SMITH, JEFFREY A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/815,450

Applicant(s)

SEAL ET AL.

Examiner

Jeffrey A. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 4/15/05
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 28-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,28-32,35-48 and 52-55 is/are rejected.
- 7) ☒ Claim(s) 33,34 and 49-51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/12/04; 4/15/05</u> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Prosecution Reopened***

In view of the Appeal Brief filed on April 15, 2005,  
PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 41 and 54 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for a claim covering every conceivable means that performs the methods of claims 1 and 54, respectively. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

Although Applicant avoids the term "means" by reciting a "system" in each of these claims (possibly to avoid a literal reading as "single means" claims), the effect is the same. See *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993); *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665; and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989).

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 28-32, 35, 38-44, 46-48, and 52-55 are rejected under 35 U.S.C. 102(e) as being anticipated by DeMello et al. (U.S. Patent No. 6,970,849 B1).

DeMello et al. '849 discloses a computer system and computer-readable medium for performing a method for invoking delivery of a digital product from a computer of an Internet vendor to a computer of a customer (col. 8, lines 49-56), while maintaining customer anonymity with respect to the vendor (see below).

The method comprises transacting a sale of the digital product to the customer; in response to the sale, transmitting to the customer a receipt for the purchase, said receipt containing a reference; receiving a request for product delivery from the computer of the customer produced from the receipt; and in response to the request for product delivery, securely transmitting to the computer of the vendor a fulfillment request containing sufficient information for the vendor to deliver the

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digital product to the customer. Applicant's attention is directed to column 3, lines 13-43.

DeMello et al. '849 discloses receiving from the vendor computer system a confirmation that the digital product has been delivered (col. 17, lines 1-4).

The method is performed without exposing any information about the customer to the vendor. The Examiner notes that DeMello et al. teaches, in some instances, that a customer's identity is revealed to the vendor. However, DeMello et al. teaches that this is not required. For example, DeMello et al. '849 teaches of a "UserName" at col. 16, lines 13-35. Here, DeMello et al. instructs that such information is required for level 3 and level 5 accesses. DeMello et al. '849 continues that "[a]lthough the foregoing examples assumes that a name will be inserted into this field, the actual contents of the field is determined by the retailer, and it could contain any information (e.g. credit card number, transaction ID, receipt ID, etc.)". An embodiment in which the retailer determines that the "UserName" field is to be populated by a transaction ID or receipt ID, for instance, reveals only the transaction ID or the receipt ID to the vendor and reveals nothing that exposes the any information about the customer to the vendor.

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The receipt comprises a URL and comprises an encoded portion that identifies the order (col. 9, lines 20-30). The receipt may be transmitted as a [web] page or as an e-mail (col. 44, lines 28-31).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36, 37, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeMello et al. (U.S. Patent No. 6,970,849 B1) in view of DeMello et al. (U.S. Patent No. 6,981,262 B1).

DeMello et al. '849 does not disclose inhibiting downloads.

DeMello et al. '262 discloses, in a similar system and method (col. 13, line 13-col. 14, line 12), discloses inhibiting downloads of the digital product to the customer once the

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digital product has been downloaded a threshold number of times (col. 17, lines 20-31).

It would have been obvious to one of ordinary skill in the art to have provided the system and method of DeMello et al. '849 to have included the step of inhibiting downloads because the merchant may view the re-downloading of the digital product as a service for which the merchant desires a fee. This decision would have been left to the discretion of the merchant (DeMello et al. '262: col. 17, lines 27-31).

#### ***Allowable Subject Matter***

Claims 33, 34, and 49-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments filed with the Appeal Brief of April 15, 2005 with respect to the rejection of claims 42 and 55 under 35 USC 101 have been fully considered and are persuasive. These rejections have been withdrawn.



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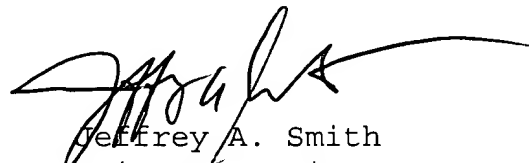
Applicant's arguments filed with the Appeal Brief of April 15, 2005 with respect to the rejections of the claims under 35 USC 103 as being obvious over Teper in view of Blinn have been fully considered and are persuasive. Therefore, these rejections have been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of DeMello et al. (U.S. Patent No. 6,970,849 B1) and DeMello et al. (U.S. Patent No. 6,981,262 B1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Smith  
Primary Examiner  
Art Unit 3625

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